

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

MSI - 787 US

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed  
name \_\_\_\_\_

N/A Filed by EFSWeb

Application Number

09/317,801

Filed

03/26/2001

First Named Inventor

Novak

Art Unit

2143

Examiner

Shin

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)☒ attorney or agent of record.

Registration number 57,971

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Signature

Richard Poucher

Typed or printed name

Telephone number

509-324-9250

Date

12/20/2006

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below.

Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**APPLICATION S/N 09/817,801 PRE-APPEAL BRIEF REQUEST FOR  
REVIEW**

**I. There is a Clear Deficiency in the Office's Prima Facie Case**

**Regarding all claims: combining Dwek with Bodin**

Pursuant to the Pre-Appeal Brief Conference Pilot Program, Applicant respectfully submits that the Office has omitted an essential element required to establish a *prima facie* rejection with respect to the subject claims. Specifically, the Office's stated motivation for combining Dwek with Bodin "in order to optimize download delivery times for the transfer of files between networked systems" is too general and could cover almost any alteration contemplated of Dwek. As such it fails to address why this specific proposed modification would have been obvious. In fact, it is not even relevant to Dwek because, as Applicant explained in its last response (filed August 1, 2006), modifying Dwek by implementing the multiple separate file downloading system of Bodin would not optimize download delivery times. In Dwek, a user does not have to initiate several download sessions to play a music selection. Instead, the user only has to highlight a music selection and press play once to have the selection immediately streamed across the internet to be decompressed (on-the-fly) and played by the media player. (See Dwek, Column 6). Accordingly, modifying Dwek as proposed would not optimize delivery times because a user in Dwek does not have to initiate several download sessions to play a music selection. Such a modification would only interfere with the facilitative functions of Dwek's user interface.

In addition, as applicant explained in its last response, modifying Dwek with Bodin would impermissibly change Dwek's principle of operation and impermissibly render it unsatisfactory for its intended purpose.

**Regarding independent Claims 1, 8, and 9**

As Applicant noted in its last response, Bodin teaches away from "download[ing] a file", as claimed by disclosing a client/server system capable of *downloading multiple separate files* on a server to a client machine. In this respect, "[t]he server streams data dynamically to the client *without creating a physical file* on the server machine." (see Column 3, lines 7-18 of Bodin) (emphasis added). Applicant directs the Office's attention to Figs. 2 and 3 of Bodin which show "a display screen where the user selects *the files resident on the server machine which will be downloaded* to the client" and "a display screen showing *files selected* by a user", respectively. (emphasis added).

**Regarding independent Claim 12, 19**

As Applicant noted in its last response, Dwek does not disclose "*one media-specific file*" or "*associating the one media-specific file with the one media content file such that any time the one media content file is played on the media player, the one media-specific file is processed to automatically display the user interface*", as claimed. (emphasis added). In addition, as Applicant noted in its last response, Dwek also fails to disclose "*one media-specific file that is configured to provide a user interface*", as claimed. (emphasis added). Finally,

Bodin, teaches away from “packaging the one media-specific file and the one media content file *in a single downloadable file*”. (emphasis added).

#### **Regarding independent Claim 25**

As Applicant noted in its last response, Bodin fails to mention “providing multiple *different files* that define different aspects of a media player *user interface*” or a “*hierarchical tag-based structure*” to accomplish an organizing act as recited in this claim. (emphasis added).

#### **Regarding independent Claim 28 and 31**

As Applicant noted in its last response, neither Dwek nor Bodin disclose or suggest “*a file that contains at least one media content file and at least one file that is configured to provide at least a portion of a media player user interface that is specific to media content associated with the one media content file*”. (emphasis added). Instead, Dwek and Bodin both *teach away* from this.

#### **Regarding independent Claim 32**

As Applicant noted in its last response, Dwek does not disclose “*a single file*” that comprises “one or more media content files”, “one or more content-specific files” and “a relationship between the one or more media content files and the one or more content-specific files “, as claimed. (emphasis added). Instead, Dwek and Bodin both *teach away* from this.

**Regarding independent Claim 39**

As Applicant noted in its last response, Dwek does not disclose “one or more media-specific files”, as claimed. Instead, the excerpt from Columns 11 and 12 merely indicates that a features pane on a user interface for a music player has a button that allows a user to create a custom appearance template for the interface. In addition, Column 15 does not mention “one or more media-specific files” that are configured in the manner recited in this claim. Finally, Bodin *teaches away* from this as well.

**Regarding independent claim 45 and 50**

As Applicant noted in its last response, Dwek does not disclose “one or more media-specific *files* that can be processed to provide a content-specific user interface”. (emphasis added). In addition, the Office has mischaracterized Bodin, which actually *teaches away* from the subject matter of these claims.

**Regarding independent claim 50**

As Applicant noted in its last response, the cited excerpts from Dwek do not disclose “one or more media-specific *files* that can be processed to provide a content-specific user interface”. (emphasis added). In addition, the Office has mischaracterized Bodin, which actually *teaches away* from the subject matter of this claim.

**Regarding independent claim 51, 55, 56, 61 and 63**

As Applicant noted in its last response, Dwek does not disclose “at least one media-specific *file* that can be processed to provide a content-specific user interface”. (emphasis added). In addition, Bodin does not disclose “a *file ... the file* comprising: one or more media content files”, “at least one media-specific file” and “at least one metafile”, as claimed. (emphasis added).

Finally, with respect to claim 56 and 61, Applicant noted in its last response that Column 7 of Dwek simply does not to disclose or suggest “automatically organizing” or to “automatically organize”, as claimed.

**II. Conclusion**

Applicant notes that it made a good faith effort to work with the Examiner in this regard by submitting PTO form PTOI-413A via facsimile (May 18, 2006) after the Office’s non-final Office Action (dated May 3, 2006). In addition, Applicant attempted to contact both the Examiner and the Examiner’s supervisor in this regard. Unfortunately, Applicant received no response and was therefore unable to schedule a teleconference to discuss these missing *prima facie* elements.

Applicant submits that all of the claims are in condition for allowance and respectfully requests that a Notice of Allowability be issued forthwith.

Respectfully Submitted,

Dated: 12/20/2006

By: 

Richard Bucher  
Reg. No. 57,971  
(509) 324-9256